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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/663,979	09/17/2003	Daniel M. Marks	110293.133US1	1953
61302 7590 09/23/2008 PTT LLC (D/B/A HIGH 5 GAMES) 1200 MACARTHUR BLVD MAHWAH, NJ 07430				
EXAMINER				
SHAH, MILAP				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/663,979

**Applicant(s)**

MARKS ET AL.

**Examiner**

Milap Shah

**Art Unit**

3714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 27 May 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 29, 30 and 32 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 29, 30 and 32 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

This action is in response to the amendment received on May 27, 2008. The Examiner acknowledges that claim 29 was amended, no claims were canceled, and no new claims were added. Therefore, claims 29, 30, & 32 are currently pending.

In view of the new grounds of rejection below, this action is being made NON-FINAL to afford the Applicant the opportunity to respond to the new rejections.

#### ***Claim Objections***

Claim 29 is objected to because of the following informalities: The conjunctive phrase “and” should be removed from the end of limitation (e) as it is included at the end of the newly added limitation (f). Appropriate correction is required.

#### ***Examiner Remarks***

In the following rejection, the Examiner has cited particular citations in the reference as applied to the claims for convenience of the Applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claims, other citations and figures may apply as well. Thus, it is respectfully requested that the Applicant, in preparing any response to this communication, fully consider each reference in its entirety as potentially teaching all or part of the claimed invention, as well as the context of the passages as taught by the prior art or disclosed by the Examiner. The Examiner is also required to give broad claim limitations their broadest reasonable interpretation in light of the ordinary level of skill in the respective art.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 29, 30, & 32 are rejected under 35 U.S.C. 102(e) as being anticipated by Bennett (U.S. Patent No. 6,585,264; of record).

**Claim 29:** Bennett discloses the same method of playing a slot machine game using a symbol matrix formed by a plurality of rows intersecting with a plurality of columns, with the plurality of rows and columns including a plurality of symbols (figures 3-8), comprising:

- a) a player making a wager to play the game (abstract);
- b) randomly rearranging the plurality of symbols (column 2, lines 4-9);
- c) displaying the rearranged symbols in the symbol matrix (figures 3-8);
- d) automatically expanding wildcard symbols, if displayed in the symbol matrix, such that each said wildcard symbol:
  - i) expands by simultaneously occupying two or more positions in the symbol matrix (figures 3-6, where a "bishop" and "rook" wildcard symbols are expanded to occupy at least two or more positions in the symbol matrix, simultaneously); and
  - ii) expands in all of the predetermined directions assigned by the directional indicia displayed on the wildcard symbol (column 4, lines 41-47, where Bennett discloses that the direction as to which the wildcard symbol will be

moving is predetermined before the movement occurs, thus, it can be reasonably interpreted that the wildcard symbols expand in all of the predetermined directions assigned by the directional indicia, that is, for example, the "bishop" wildcard symbol as discussed by Bennett has two possible paths within the display of figure 3, the controller selects one of the paths before movement is to occur, upon movement, it can reasonably be interpreted that the bishop wildcard symbol moved in *all of the predetermined directions* assigned by the directional indicia displayed on the wildcard symbol, where all includes a single direction selected by the game);

c) always replacing the symbol(s) in the path of an expanding wildcard symbol with the expanding wildcard symbol (figure 6, where within the predetermined path of the wildcard symbols, each underlying symbol is replaced);

f) evaluating winning symbol combinations formed using expanded wildcard symbols, wherein each said wildcard symbol may act as any other symbol in order to form a winning symbol combination (column 4, lines 23-27, where after all wildcard symbols make their respective movements and change all underlying symbols within said movement, the game evaluates for newly made winning combinations using the wildcard symbols, such as in figure 6, an award for three "10" symbols is provided, where the third "10" symbol is the bishop wildcard symbol); and

g) issuing awards for winning symbol combinations following the expansion of all wildcard symbols (column 4, lines 23-27).

**Claim 31:** Bennett discloses directional indicia that assign at least a downward direction from the symbol position in which the wildcard symbol appears (figures 3-6, where the

Art Unit: 3714

"rook" wildcard symbol appears in the fifth column, first row and expands in a downward direction).

**Claim 32:** Bennett discloses the use of at least words as directional indicia (i.e. "bishop" or "rook", as clearly seen in figures 3-8).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 29, 30, & 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over O'Halloran (U.S. Patent No. 6,439,993; of record).

**Claim 29:** O'Halloran discloses a method of playing a slot machine game using a symbol matrix formed by a plurality of rows intersecting with a plurality of columns, with the plurality of rows and columns including a plurality of symbols (figures 2-3), comprising:

- a) a player making a wager to play the game (column 1, lines 8-11);
- b) randomly rearranging the plurality of symbols (claim 1 of O'Halloran);
- c) displaying the rearranged symbols in the symbol matrix (claim 1 of O'Halloran);
- d) automatically expanding wildcard symbols, if displayed in the symbol matrix, such that each said wildcard symbol (figure 3, column 2, line 60 – column 3, line 45):
  - i) expands by simultaneously occupying two or more positions in the symbol matrix (figures 4-5); and

- ii) expands in all of the predetermined directions assigned to the wildcard symbol (figures 4-5);
- e) always replacing the symbol(s) in the path of an expanding wildcard symbol with the expanding wildcard symbol (column 2, line 60 - column 3, line 9, where in one embodiment, the symbols in the path of the expanding wildcard symbol are always replaced);
- f) evaluating winning symbol combinations formed using expanded wildcard symbols wherein each said wildcard symbol may act as any other symbol in order to form a winning symbol combination (column 2, lines 64-67); and
- g) issuing awards for winning symbol combinations following the expansion of all wildcard symbols (column 3, lines 18-30).

O'Halloran, however, lacks an explicit disclosure of directional indicia displayed on the wildcard symbols to indicate a direction of movement or path of movement for the expansion of the wildcard symbol. Regardless of such a deficiency, the Examiner submits that such directional indicia are merely a matter of aesthetic design choice. O'Halloran clearly teaches wildcard symbols that expand in multiple directions (figure 4-5). O'Halloran depicts multiple possible wildcard expansion paths based on random or pseudo-random determination of continuing expansion or stopping it. That is, for example, the outcome of the trigger wildcard symbol in figure 4b differs from the outcome of the trigger wildcard symbol in figure 4d, in that the random or pseudo-random determination by the game resulted in the 5th reel of figure 4d not obtaining an expanded wildcard symbol. Nonetheless, clearly the concept of wildcard symbols and movement in multiple paths is taught by O'Halloran. O'Halloran teaches that those of ordinary skill in the art would have had the common knowledge and routine skill to substantially similar inventions without

departing from the scope of the present invention (column 3, lines 45-49). Thus, the Examiner submits that explicitly displaying directional indicia over a wildcard symbol is a matter of obvious design choice directed to mere aesthetics. The function of the wildcard symbol is equivalent in O'Halloran and applicant's invention, where the Applicant appears to have merely added a graphic overlying the wildcard symbol to indicate to the player in which direction the movement of the wildcard symbol will occur. Frankly, without such indicia, the prior art performs equally the same as Applicant's invention. There appears to be no criticality or unexpected results obtained from merely indicating on the wildcard symbol the direction of movement. It may be argued that the specific symbol or directional indicia actually "assigns" the direction to the wildcard symbol, however, the Examiner's interpretation of Applicant's specification appears to indicate the processor selects a direction and indicia is selected to overly the wildcard symbol to be commensurate with the predetermined direction. Regardless, again, the indicia appear to be merely for aesthetic purposes. MPEP 2144.04, section I entitled "Aesthetic Design Changes" explicitly discusses that the courts have held "that matters relating to ornamentation only which have no mechanical function cannot be relied upon to patentably distinguish the claimed invention from the prior art".

Therefore, it would have been obvious to those of ordinary skill in the art, improving upon O'Halloran, to modify O'Halloran by displaying specific directional indicia on the wildcard symbols to indicate to a player which direction the wildcard symbol will be expanding for at least the purpose of aesthetics as discussed herein.

**Claim 30:** O'Halloran discloses at least the wildcard symbol being assigned movement either leftwards or rightwards from the symbol position in which the wildcard symbol appears (figures 4-5).



Art Unit: 3714

**Claim 31:** As discussed above, the specific indicia displayed on the wildcard symbol is a matter of design choice directed to mere aesthetics.

### ***Response to Arguments***

Applicant's arguments with respect to claims 29, 30 & 32 have been considered but are moot in view of the new ground(s) of rejection.

It should be noted the Examiner re-evaluated the previous rejection and the claimed invention; consequently, based on a broader interpretation of the claimed invention, the Examiner has removed the Locke reference. Thus, the Applicant's arguments appear moot. A rejection in view of Bennett alone is provided above. Additionally, a secondary rejection as obvious over O'Halloran is also provided. In view of these newly added rejections, this action is being NON-FINAL to afford the Applicant the opportunity to respond to any updated or new rejections.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The Applicant is directed to the attached "Notice of References Cited" for additional relevant prior art. The Applicant is requested to review each reference as potentially teaching all or part of the claimed invention.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Milap Shah whose telephone number is (571)272-1723. The examiner can normally be reached on M-F: 9:30AM-6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Pezzuto can be reached on (571) 272-6996. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3714

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Robert E Pezzuto/  
Supervisory Patent Examiner, Art Unit 3714

/MBS/